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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,706	12/04/2001	Kanwaljit Singh Girn	FGX-100US	7051

23122 7590 12/16/2004

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EXAMINER	
LY, CHEYNE D	

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/010,706	GIRN ET AL.	
	Examiner	Art Unit	
	Cheyne D Ly	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *October 28, 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) *12-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-25* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election without traversal of Group I, claims 1-11, filed October 28, 2003, is acknowledged.

2. Claims 1-11 are examined on the merits.

OBJECTIONS

3. The title of the invention is not descriptive because instant tile is directed to a method and apparatus while the elected claims are directed to a method. A new title is required that is clearly indicative of the invention to which the claims are directed.

CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Specific to claim 1, lines 3-4, the recitation of "establishing a connection between the individual in a first computing environment and a data gathering and evaluation system" causes said claim to be vague and indefinite because it is unclear whether the connecting is established between "the individual" or information representing "the individual." Due to the phrase "the individual in a first computing environment" wherein the "computing environment" has not been specifically defined, a reasonable interpretation of the claim is that the connection is established between information representing "the individual" and "a data gathering and evaluation system." An alternative interpretation is that the connection is established by having an individual being

within the proximity of a computing environment. The same issue is present in claim 11. Further, claim 5, lines 2-3, recites the limitation of "the individual only on the first computing environment" which has the same unclarity issue. Claims 2-10 are rejected for being dependent from claim 1.

CLAIM REJECTIONS - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1 and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff (US 5594638 A) taken with Evans (US 5642936 A).

10. Iliff describes a method for providing computerized, knowledge-based medical diagnostic and treatment advice wherein an individual connects to medical diagnostic and treatment advice (MDATA) (second computing environment) via a telephone with a touch-tone pad (first

computing environment) (column 6, lines 29-37 and Figure 1). The individual selects an algorithm dealing with is identified complaint and the system attempts to diagnose the cause for the disease such as genetic or tumor (cancer). The system determines if the medical condition exists (column 35, lines 33-56), as in instant claims 1 and 11, lines 1-5.

11. The MDATA system comprising seven related databases directed to the patient and diseases (column 20, line 45, to column 22, line 59). The system presents a menu to the patient and asks the patient to identify (selection) the complaint for diagnosis (column 27, lines 25-33). The patient selects an algorithm dealing with said identified complaint and the system attempts to diagnose the cause for the disease such as genetic or tumor (cancer). The system determines if the medical condition exists (column 35, lines 33-56), as in instant claim 1, lines 6-10.

12. The MDATA system classifies potential health hazards related to personal and family history (column 12, lines 40-44). The system presents a menu to the patient and asks (prompts) the patient to identify (selection) the complaint for diagnosis (column 27, lines 25-33). Further, The patient medical history database is created by the use of a past medical history questionnaire (prompts) (column 23, lines 38-46), as in instant claim 1, lines 11-14.

13. The system calculates (analyzing) the probability of having the disease (column 39, line 65, to column 40, line 3) and generates appropriate reports for the individual (column 22, lin19-28), as in instant claim 1, lines 15-19.

14. A secured connection is established by using a PIN (column 29, lines 9-26), as in instant claim 4.

15. However, Iliff does not describe the limitation of analyzing the received family history data to determine the susceptibility of the individual to the selected illness.

16. Evans describes a computer implemented method for determining the existence of a hereditary disease risk in a patient using analyzing a database having information directed to family history specific to a disease such as cancer (column 2, lines 1-47), as in instant claim 1, lines 14-16; and claim 11, lines 6-15.

17. Iliff describes the association of the seven databases with comprising information identifying the individual (column 21, line 7, to column 22, line 59). Evans describes the method for obtaining a database with the cancer family history of cancer-affected individuals (column 5, lines 25-27). The individual connects to medical diagnostic and treatment advice (MDATA) (second computing environment) via a telephone with a touch-tone pad (first computing environment) (column 6, lines 29-37 and Figure 1). Due to the vague and indefinite issue directed to the limitation of "the individual only on the first computing environment", the citations above has been reasonably construed to be consistent with the required limitation of instant claim 5.

18. Evans describes a procedure for printing out results directed to the probability of the hereditary disease for the individual according to the family histories (column 11, lines 18-65), as in instant claims 6-8, 10, and claim 11, lines 16-18.

19. Evans describes a procedure for printing out results directed to the probability (heuristic risk analysis) of the hereditary disease for the individual according to the family histories (column 11, lines 18-65). From such a family tree, the patterns of hereditary cancer can be detected by expert clinical oncologists. Subsequently proper surveillance and management may then be ascertained in concert with judicious gene testing, if and when available, to confirm the risk evaluation (column 1, lines 29-34). The instant specification defines the limitation of

"heuristic risk analysis" as various bodies of medical opinion have created public domain guidelines for the identification of those at risk of developing diseases (page 28, paragraph [0110]). Therefore, the above citation of Evans is consistent with the limitation of "heuristic risk analysis" as in instant claim 9.

20. Iliff describes a method for providing computerized, knowledge-based medical diagnostic and treatment advice wherein an individual connects to the MDATA system, and consumers and providers participate in the improvement of said system (column 6, lines 29-37, Figure 1, and column 64, lines 34-37).

21. An artisan of ordinary skill in the art at the time of the instant invention would have been motivated by the improvement described by Iliff to associate the family history database and method analysis of said database of Evans to said MDATA system. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a method for providing computerized, knowledge-based medical diagnostic and treatment advice wherein an individual connects to the MDATA system having the associated databases as described by Iliff and Evans.

22. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff (US 5594638 A) taken with Evans (US 5642936 A) in view of Geller et al. (1997).

23. Iliff and Evans describe the limitations to claims 1 and 4-11 as discussed above. However, Iliff and Evans do not describe the limitations to claims 2 and 3.

24. Geller et al. describes a method of genetic testing for susceptibility to cancer comprises providing genetic counseling (page 1468, column 3, last line, to page 1469, column 1, line 2) and

educational materials such as brochures and pamphlets to the individual (page 1469, Process of Education: Formats of Disclosure §, columns 2-3), as in instant claims 2 and 3.

25. Iliff describes a method for providing computerized, knowledge-based medical diagnostic and treatment advice wherein an individual connects to the MDATA system, and consumers and providers participate in the improvement of said system (column 6, lines 29-37, Figure 1, and column 64, lines 34-37).

26. An artisan of ordinary skill in the art at the time of the instant invention would have been motivated by the improvement described by Iliff to associate the family history database and method analysis of said database of Evans to said MDATA system, and provide genetic counseling and educational materials as taught by Geller et al. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use a method for providing computerized, knowledge-based medical diagnostic and treatment advice wherein an individual connects to the MDATA system having the associated databases with the provision of genetic counseling and educational materials as described by Iliff, Evans, and Geller et al.

CONCLUSION

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

28. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is

(866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

29. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

C. Dune Ly
12/13/04

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12/13/04